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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,866	11/15/2005	Martin Becker	W1.1982 PCT-US	8992

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EXAMINER

OMGBA, ESSAMA

ART UNIT	PAPER NUMBER
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3726

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/532,866	Applicant(s) BECKER ET AL.	
	Examiner Essama Omgba	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-86 is/are pending in the application.
- 4a) Of the above claim(s) 36-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-54 and 57-86 is/are rejected.
- 7) ☒ Claim(s) 55 and 56 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 April 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :4/28/2005, 8/28/2007, 10/24/2007 & 11/7/2008.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of the invention of Group II, claims 47-86, in the reply filed on February 2, 2009 is acknowledged.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: circumference "U". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: on page 2, line 4, "forconducting" should read --for conducting--; on page 4, line 15, "in" last occurrence should be deleted and the line should end with a semi-column (;); on page

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5, lines 1, 3 and 4, "in" last occurrence should be deleted and each line should end with a semi-column (;); and in line 6, "and in" should be deleted and the line should end with a semi-column (;); on page 9, line 2, "extendingaround" should read --extending around-; on page 10, line 6, "situationwith" should read --situation with--; and on page 14, line 11, "byelectron" should read --by electron--.

Appropriate correction is required.

Claim Objections

4. Claims 50, 54, 56, 58, 60, 62, 64, 66, 68, 70, 72, 74, 76, 78, 80 and 82 are objected to because of the following informalities: in claim 50, line 6, "said" third occurrence should read --each--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 60 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 60 recites the limitation "said profiled body" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 83-86 are rejected under 35 U.S.C. 102(b) as being anticipated by Stegmeir et al. (US Patent 5,329,853).

With regards to claims 83 and 84, Stegmeir et al. discloses a rotating body useable in a printing press (col. 2, lines 27-28), the rotating body comprising a rotating body barrel 1 having an outer shell face (covered by blanket 5), an opening 2 in the shell face, and first and second oppositely located edges (angled ends of blanket 5) on the opening adjacent the shell face, the edges being made of a corrosion-resistant material (col. 2, lines 29-31).

Regarding claim 85, see profiled body (3, 4) and angled edges of blanket 5 formed on the profiled body (3, 4).

Regarding claim 86, see figure 1.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 47-49, 51-53, 57, 59, 61, 63, 65, 67, 69, 71, 73, 75, 77, 79 and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heller (DE 196 11 642) in view of Schneider et al. (US Patent 6,543,358).

With regards to claim 47, Heller discloses a rotating body useable in a printing press comprising a rotating body barrel 1, the barrel having an outer shell face (covered by shell 4), a groove formed in the shell face, the groove including joining surfaces spaced apart from each other in a circumferential direction of the barrel, the groove having a groove depth in a radial direction of the barrel (fig. 1), a profiled body (12, 14) in the groove and being welded together with the barrel on the joining surfaces, the profiled body at least partially covering the groove, see figure 1 and the abstract.

Although Heller does not disclose a profiled body structural depth less than the groove depth, however it is known to provide profiled bodies in grooves of rotating body barrel wherein the profiled bodies structural depth is less than the depth of the groove as attested by Schneider et al., see figure 1 with profiled body 24 in a groove of barrel 01. therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a profiled body in the rotating body of Heller, wherein the profiled body has a depth that is less than the depth of the groove, in light of the teachings of Schneider et al., in order to provide a profiled body with a depth suitable for the intended use.

Regarding claim 48, Applicant should note that the grooves disclosed by Heller and Schneider could be used as flow channels.

Regarding claim 49, see figure 1 of Heller or figure 1 of Schneider et al.

Regarding claims 51-53, Applicant should note that the rotating body of Heller/Schneider et al. is arranged in a printing press and that the groove therein extends in an axial direction of the rotating body and at least partially in the circumferential direction of the rotating body.

Regarding claim 57, Applicant should note that the process of making the profiled body lends no patentable weight to the product being claimed.

Regarding claim 59, the profiled body disclosed by Schneider et al. could be considered shaped as a strip in an axial direction of the rotating body, see column 2, lines 65-66.

Regarding claim 61, see the profiled bodies in Schneider et al., (column 4, lines 3-5).

Regarding claims 63 and 65, Applicant should note that it is within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

Regarding claims 67, 69 and 71, see figure 1 of Heller.

Regarding claims 73 and 75, Applicant should note that it is within the general skill level of a worker in the art to select a known welding process that would be suitable for the welding process.

Regarding claim 77, applicant should note that such barrels are typically made of corrosion-susceptible material.

Regarding claim 79, Applicant should note that it is known to cover the shell face with a corrosion-proof protective layer.

Regarding claim 81, see figure 1 of Heller or Schneider et al.

11. Claims 50, 54, 58, 60, 62, 64, 66, 68, 70, 72, 74, 76, 78 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heller in view of Dorow et al. (US Patent 5,003,878).

With regards to claims 50 and 62, Heller discloses a rotating body useable in a printing press comprising a rotating body barrel 1, the barrel having an outer shell face (covered by shell 4), an axially extending groove formed in the shell face, the groove including joining surfaces, a profiled body (12, 14) in the groove and being welded together with the barrel on the joining surfaces, the profiled body at least partially covering the groove, see figure 1 and the abstract. Heller does not disclose the profiled body made of first and second profiled bodies, the profiled bodies being spaced apart from each other in a circumferential direction of the barrel, a slit-shaped opening defined by the first and second profiled bodies and located at the shell face, a securement channel formed by the first and second profiled bodies and arranged in the groove, and at least one dressing holding means in the securement channel and adapted to hold a dressing arranged on the shell face. However Dorow et al. teaches such first and second profiled bodies 5, with a slit-shaped opening 4, a securement channel (figure 1), and one dressing holding means 7 in the securement channel and adapted to hold a

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dressings 9 arranged on the shell face, see column 2, lines 16-36. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have substituted the profiled body of Heller with the ones taught by Dorow et al., in order to achieve the benefits of using such profiled bodies.

Regarding claims 54, Applicant should note that the groove in the rotating body of Heller/Dorow et al. extends at least partially in the circumferential direction of the rotating body.

Regarding claim 58, Applicant should note that the process of making the profiled body lends no patentable weight to the product being claimed.

Regarding claim 60, Applicant should note that the profiled bodies disclosed by Dorow et al. could be considered shaped as strips in an axial direction of the rotating body, see column 2, lines 65-66.

Regarding claims 64 and 66, Applicant should note that it is within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

Regarding claims 68, 70 and 72, see figure 1 of Heller.

Regarding claims 74 and 76, Applicant should note that it is within the general skill level of a worker in the art to select a known welding process that would be suitable for the welding process.

Regarding claim 78, applicant should note that such barrels are typically made of corrosion-susceptible material.

Regarding claim 80, Applicant should note that it is known to cover the shell face with a corrosion-proof protective layer.

Regarding claim 82, see figure 1 of Heller.

Allowable Subject Matter

12. Claims 55 and 56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Essama Omgba whose telephone number is (571) 272-4532. The examiner can normally be reached on M-F 9-6:30, 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Essama Omgba/
Primary Examiner, Art Unit 3726

eo
May 19, 2009